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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/086,014
Filing Date: February 28, 2002
Appellant(s): HUGHS-BAIRD ET AL.

Adam H. Masia
For Appellant

MAILED
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GROUP 3700

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 20th, 2007 appealing from the
Office action mailed October 13th, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 1 to 10, 18, and 20 under 35 U.S.C. 112, 1st paragraph is withdrawn by the Examiner.

(7) Claims Appendix

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The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,648,754

Baerlocher et al

11-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-10 18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Baerlocher et al (US 6,648,754)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e).

Regarding at least claim 1, Baerlocher et al teaches a gaming device having a game comprising:

A plurality of values (equivalently offers) greater than zero and payable to the player (Element 100);

a plurality of player selectable masked selections (Elements 108a-108x);

an input device (Elements 44, 50);

a memory device storing a plurality of instructions (Elements 44, 46, 48);

a display device (Figure 1, & Elements 30, 32); and

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a processor adapted to communicate with the display device and input device (Figure 2), said processor operable to execute said instructions to operate with said display device and said input device for each play of the game to further (Col 5:31-51):

(a) directly and individually associate said offers with a separate one said selections (Col 6:47-63);

(b) enable a player to select one of said selections (Col 6:47-63);

(c) reveal the value/offer directly and individually associated with the selected selection to the player (Col 6:47-63);

(d) enable the player to accept or reject the revealed value (Col 6:52-63); and

(e) repeat steps (a) through (d) at least once if said player rejects said revealed value, wherein if the player rejects said revealed values/offers, said revealed value is directly and individually re-associated with one of said masked selections for at least one subsequent selection of step (a) (Col 10:36-44).

(f) if the player accepts said revealed offer, paying said revealed offer to the player (Col 7:5-16)

The offers of Baerlocher are directly and individually associated with each of the selections through a cumulative step value as shown in at least figure 4 of Baerlocher. It is additionally noted that though the claim language sets forth "directly and individually" associating the offers with the selections thereby setting forth an arrangement defining the relationship of each offer being associated with

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a singular selection but is silent with the number of singular offers that may be associated with each selection. The defined arrangements encompasses a one-to-many relationship juxtaposed to a one-to-one relationship.

Regarding claims **2-3**, the plurality of values are randomly selected and associated with game selections (Col 7:40-61) from a pool of offers wherein the "pool" of offers includes all tangible game offers.

Regarding claims **4, 7 and 9**, Baerlocher teaches that the number of selections may correspond to an equal number of offers (Col 8:9-11; 8:28-38).

Regarding claim **5**, Baerlocher additionally teaches the inclusion of a number of offers greater than the number of selections in the realization of "the present invention includes not associating or placing one or more possible steps" (Col 7:45-61).

Regarding claims **6 and 10**, Baerlocher additionally teaches the inclusion of a number of offers less than the number of selections. Wherein a step number is associated with each possible selection shown in figure 4b contains the use of repeated specific values such as the number 23 (Col 7:40-60). Hence as understood this can be interpreted as a number of unique values less than the number of selections.

Regarding claim **8**, Baerlocher teaches the re-association (reshuffling) of values with selection after the user rejects one selection (Col 10:29-44).

Regarding at least claim **18**, Baerlocher et al teaches a gaming device having a game wherein each play of said game comprises:

(a) triggering a play the game (Col 6:8-39);

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- (b) directly and individually associating a plurality of offers with a plurality of selections, such that each offer is directly and individually associated with a separate one of the selections, wherein said plurality of offers are each payable to the player(Col 6:47-51 & Col 7:5-16);
- (c) displaying a plurality player available selections (Figures 4-5);
- (d) revealing one of said offers directly and individually associated with the said selections to the player(Col 6:47-51 & Figure 5b);
- (e) enabling the player to select/pick one of the selections (Col 6:47-51) ;
- (f) revealing one of said offers directly and individually associated with the respective player picked/selected selection to the player (Col 7:29-39 & Figure 4);
- (g) enabling the player to accept or reject said revealed offer (Col 6:47-51);
- (h) providing the offer to the player if the player accepts said offer or if the offer is the last offer(Col 7:5-16); and
- (i) repeating steps (b) through (h) if the player rejects said offer and the offer is not the last offer, wherein if the player rejects said revealed offer, for said repeat of step (b) said revealed offer is directly and individually reassociated with one of said selections for at least one subsequent selection by the player (Col 10:30-44).

Regarding claim **20**, the apparatus/method of Baerlocher teaches revealing a singular value associated with each selection and hence this singular value must represent the maximum and minimum offer (Figure 4).

(10) Response to Arguments

The Appellant's brief fails to set forth an exemplary claim accordingly claim 1 has been selected as an exemplary claim.

(i) Appellant's Brief Sections 1(A) through 1(B) – [Appellant's Brief Pages 13 through 21]:

Appellant's brief sections 1(A) and 1(B) relate to the Appellant's general characterization of the prior art and do not directly address the rejection of claims on appeal. The Examiner's rebuttal of these sections is reserved for Examiner's directed rebuttal of the Appellant's arguments, which rely on these characterizations and is presented in the following sections.

(ii) Appellant's Brief Section 1(C) – [Pages 21 through 22]:

(A) The Appellant's brief suggests that the association of the offers with the selections in a **direct** and **individual** manner provides features that are not allegedly taught by the applied prior art reference of Baerlocher.

The crux to this argument purporting a separation based on a component is the definition and scope of the terms ***directly*** and ***individually***. The Appellant's specification as well as the prior art of Baerlocher fails to mention the terms ***direct/directly*** and ***individual/individually*** and accordingly fails to provide a clear definition of these terms with relation to a computer gaming device. Additionally, the Appellant's claims fail to clearly define the terms ***direct*** and ***individual*** within the context of their presentation. It is further noted that even at the time of writing this Examiner's Answer even the Appellant's brief fails to set forth any constructive definition of these term and instead attempts to characterize this language only in so much as to allege that the prior art of Baerlocher doesn't teach the features corresponding to these terms. In absence of a clear definition of these the terms there are however on occasion intrinsic features of the claimed invention that will provide a degree of measure for the argued terminology.

For instance the Appellant implies, through presented arguments, that the "***individually***" claim terminology sets forth a one-to-one correspondence between the selection element and a prize offer (Appellant's brief Page 22). However, Appellant's claim 10, which depends from exemplary claim 1, directly contradicts this relationship by setting forth a relationship wherein an offer is associated with a plurality of selections. Hence, by the Appellant's own dependent claims, the "***individually***" relationship between the selection and the offer cannot be so narrowly defined as to limit the claim language to a one-to-one correspondence as suggested by the Appellant's arguments.

With respect to the “**directly**” claim term, the Appellant’s claims fail to define or limit the scope of a “**directly**” relationship. The Appellant’s own exemplary embodiment and claims set forth a computer structure for electronically displaying selection elements that are electronically correlated to a plurality of electronic prize offers through an implicit data mapping (Appellant’s specification pages 8-10, & 12-13). As disclosed the Appellant’s “**directly**” association between the selection and an associated prize offer includes the indirect components of an electronic gaming device, which the program method requires to enable the operation of the method.

A common definition for the term **direct** is the absence of an intervening step or process yet the claimed process when realized in a computer environment would inherently include a plurality of intervening steps. For instance, a formula or procedure for associating the prize offers with the selections would be required according to the Appellant’s specification. The Appellants specification further presents this procedure as a random association of elements with each iteration of the disclosed method (Appellant’s specification page 12, Lines 21-23). Hence the use of this term as argued includes at least one intervening step by the Appellant’s own disclosure. Additionally the Appellant’s selective interpretation of the term “**directly**” relies on ignoring the electronic and software components of the Appellant’s claimed invention which enable it’s functionality and specifically that a software environment can realize a direct relationship of functionality in absence of the supporting structure. A computer environment, such as an electronic gaming machine, utilizes multiple

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data correlations to identify the interface elements of the selection element and data elements corresponding to the respective offers is inherent to the nature of a random assignment process and processor environment as disclosed in the specification. Yet the Appellant's arguments and specification overlook such elements and instead quantify this relationship as a **direct** relationship in essence ignoring the vehicle that enables the realization of the method and steps associated therewith ultimately yielding a definition of direct which does not preclude the inclusion of any intervening steps but instead attempts to draw a distinction between the steps of the prior art and the instant invention premised on a vague characterization of the step accumulation of the prior art.

With respect to the prior art, Baerlocher is viewed to define a direct relationship between the selection elements and the prize offers through the use of an accumulation of steps wherein for each iteration of the invention of the prior art of Baerlocher the respective selection elements have a known and predetermined relationship to the prize offers. For instance, if the player selects a selection corresponding to seven steps in the first iteration the prize offer directly and individually associated with that selection is 30 credits (Figure 5) and if they were to refuse that offer in favor of a subsequent exemplary selection of eight additional steps, the prize correlated to the selection element 1081 is 70 credits. Regardless of the accumulation of steps, for each iteration of Baerlocher's method each selection element is correlated to a particular prize amount prior to the participants selection of that element during the round of play. While the instant Application does not incorporate the features of steps such as

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demonstrated in the invention of Baerlocher it fails to bar the inclusion of such additional steps while the use of the term direct is not defined nor presented in such a manner to provide for the inclusion of certain intervening steps or component but not others. Accordingly the broader claims of the instant application would necessarily encompass the patented claims. As discussed the **direct** and **individual** claim language at best vaguely described and at points contradicts the disclosed invention affording the language limited patentable weight.

(B) The Appellant alleges that upon rejection of an offer, said offer is not directly and individually reassociated with a selection for latter selection by the player in the prior art of Baerlocher.

The language **directly** and **individually** has been addressed in the subsection above enumerated (iii)(A) and will not be repeated herein for the sake of brevity.

The re-association feature is demonstrated in figure 5 of Baerlocher. With reference to the previously present example of Appellant's figure 5 if the participant selects a selection corresponding to three steps (Element 108e) in the first iteration the prize offer directly and individually associated with that selection is 20 credits (Figure 5 Element 100) and if they were to refuse that offer in favor of a subsequent exemplary selection of two additional steps (yielding a total of five steps in the correlation of Baerlocher) , the prize correlated to the selection element 108n is once again 20 credits. Accordingly the prize of 20 credits has

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been re-associated with a selection for a subsequent round of the selection game. Hence as demonstrated by example, upon rejection of an offer, said offer is directly and individually reassociated with a selection for later selection by the player in the prior art of Baerlocher.

(iii) Appellant's Brief Section 1(D) – [Pages 23 through 24]:

Appellant argues that the prior art of Baerlocher does reveal the offer directly and individually associated with the selection.

The language directly and individually has been addressed in the subsection above enumerated (iii)(A) and will not be repeated herein for the sake of brevity.

The prior art of Baerlocher clear demonstrates the step of revealing the offers associated with the selection (shown as element 102 of figure 5B) and the subsequent revealing of a an offer associated with a subsequent selection (shown as element 102 of figure 5C). Hence the prior art of Baerlocher does in fact provide the step revealing the offer **directly** and **individually** associated with the selection and the subsequent selection in contradiction to the Appellant's allegations.

(iv) Appellant's Brief Section 1(E) – [Pages 25 through 26]:

During prosecution of the application two interpretations of the claimed offers arose and were presented concurrently during prosecution. For the proposes of the appeal only the correlation of the prior art offers to the present

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claim offers remains. Accordingly Appellant's arguments directed to demonstrating a distinction between the steps of Baerlocher and the prior art will not be addressed by the Examiner in favor of rebutting the Appellant's arguments attempting to separate the offer of the prior art of Baerlocher from the offers of the claimed invention.

In subsection (i) on pages 25 through 26 the Appellant argues that the offers of Baerlocher are associated with a number of accumulated steps and are divorced of any direct or individual relationship between the offers and the players selection. However, as presented above, for each iteration of the game of Baerlocher each selection, once mapped to it's respective value, correlates to a particular offer amount. The accumulation of steps, though present in the prior art of Baerlocher, serves merely as a mapping feature between the player selection and the offer value. The steps values do not change during a particular round of play, meaning the association between the player selectable selection and the offer does not change once the association has been randomly determined and mapped based on that random determination. In the same manner the Appellant's claimed invention randomly determines and maps an association, which is similarly fixed during the round of play (Appellant's specification page 12 lines 21 through 25). Yet despite this and the discussion regarding the scope and weight of the terms "**directly**" and "**individually**" as presented above, the Appellant continues to argue in this section that the inclusion of steps, such as those included in the prior art invention of Baerlocher, must be specifically prohibited through the use of the terms direct and individual.

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It is submitted to the honorable board that such holding must be in error, and attempts to maintain a delineation between the prior art and the instant application that is not supported by the practiced definitions of the terms direct and individual as set forth by this Application. And further wherein the Appellant has effectively utilized the term individual to refer to a correlation of one offer to many selections juxtaposed to the singular arrangement argued and wherein the Appellant has further utilized the term direct in an attempt to draw a distinction between a random mapping of values as presented in this application juxtapose to a random mapping including step values. These delineations are not supported by the common definition of these terms or as disclosed by the Appellant's specification to be their intended meaning thereby failing to provide any basis for the Appellant's proposed distinction.

Conclusion

The Appellant presents arguments in the attempt to establish a delineation between their claimed invention and the invention of Baerlocher. These arguments however, are commonly reliant on a narrow interpretation of the terms "directly" and "individually", which is plainly not supported by the Appellant's disclosure or common meaning as shown above. Accordingly it is submitted that the arguments must fail for their reliance on an excessively narrow interpretation of these terms and that the pending rejections should be maintained

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

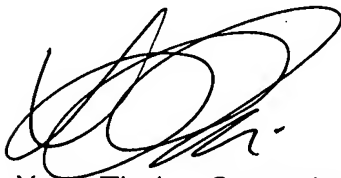
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Robert Mosser Patent Examiner Art Unit 3714

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